

REMARKS

Status of Application

Claim 1 is pending in the application. In a non-final Office Action dated July 13, 2004 ("Office Action"), the Examiner:

1. Objected to the Information Disclosure Statement filed with the patent application because "the non-patent literature documents are in improper form for citation of electronic documents."

2. Objected to claim 1 because of the informality at line 25 whereby "at least test taker" should be "at least one test taker."

3. Rejected claim 1 under the judicially created doctrine of obviousness type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,681,098 in view of Sonnenfeld (U.S. Patent No. 6,112,049).

In this response, Applicants have included a supplemental Information Disclosure Statement which lists the non-patent literature documents in proper form for citation of electronic documents and which also supplies copies of the documents listed on the supplemental Information Disclosure Statement.

Applicants have also updated the specification, page 1, paragraph 1 to reflect that the parent application 09/757,989 has subsequently issued into U.S. Patent No. 6,681,098.

Applicants have also amended claim 1 at line 25 to address the informality identified by the Examiner.

Finally, Applicants include herewith a terminal disclaimer in compliance with 35 CFR 1.321 (c) to overcome the non statutory double patenting rejection. As noted therein, this application, 10/757,223, and U.S. Patent No. 6, 681,098 are each 100% commonly owned by Performance Assessment Network, Inc. The assignment of this application to Performance Assessment Network, Inc. is shown at Reel/Frame No. 014898/0093. The assignment of U.S. Patent No. 6,681,098 to Performance Assessment Network, Inc. is shown at Reel/Frame No. 011448/0616.

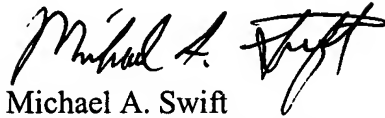
CONCLUSION

For all the foregoing reasons it is respectfully submitted that Applicants have addressed each of the issues raised in the July 13, 2004 Office Action and that Applicants have made a patentable contribution to the art. It is respectfully submitted that this response places the above identified application in condition for allowance. Favorable reconsideration and allowance of the pending claim is respectfully requested. Applicant believes that this response to Office Action is timely filed and consequently no fee for extension is due. However, a check in the amount of \$55.00 is included herewith to cover the fee for the terminal disclaimer pursuant to 37 CFR § 1.20(d). In the event Applicant has inadvertently overlooked the need for an extension of time or payment of a fee, Applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 09-0007.

Commissioner for Patents
September 20, 2004
Page 7

Respectfully submitted,

ICE MILLER

A handwritten signature in black ink, appearing to read "Michael A. Swift", written in a cursive style.

Michael A. Swift

Attorney Registration No. 44,367

ICE MILLER

One American Square, Box 82001
Indianapolis, IN 46282-0200

MAS/sg

Enclosure: Terminal Disclaimer
Information Disclosure Statement
Check in the amount of \$55.00
Return Postcard